

REMARKS

Claims 1-45 remain in this case for consideration. Claims 1-6, 9-11, 14-17, 20, 22, 24-25, 27, 28-30, 35, 37-39 and 41-45 have been amended to improve grammar and better define Applicant's invention.

A. **Formal Matters**

The inventors' "Declaration" has been objected to as purportedly being defective because it does not identify the mailing address of each inventor. In response, Applicants respectfully submit that they have already provided a proper inventor "Declaration" on an approved Patent Office form (i.e., Form PTO/SB/01A), an approved form which does not require statement of the inventors' mailing addresses. Following accepted Patent Office practice, the inventors' mailing addresses were instead stated on the "Application Data Sheet" submitted with the present application. This previously submitted "Application Data Sheet" states inventor Watler's mailing address as 5341 East 4th Street, Long Beach, CA 90814-1920 and inventor Hanley's mailing address as 1315 Franklin Street #D, Santa Monica, CA 90404. Since Applicants have already complied with the applicable Patent Office regulations, Applicants submit that there is no need for a new oath or declaration.

Applicants' "Power Of Attorney" has been objected to because it transposes two digits in the patent application number (i.e., Application No. 09/915,302 instead of Application No. 09/915,203). To correct this obvious typographical error, Applicant is submitting a replacement "Power Of Attorney" and "Statement Under 3.73(b)" which identifies the correct patent application number.

Applicants' informal drawings have been objected to as failing to comply with Patent Office rules. To overcome this basis of objection, three sheets of replacement formal drawings are submitted with this Amendment.

The "Abstract Of The Disclosure" is objected to because it includes the internal document identification number for Applicants attorneys in the lower left hand corner. To overcome this basis of objection, Applicants' have rewritten the "Abstract Of The Disclosure" in

a way which both better describes Applicants' invention and omits the internal document identification number for Applicants' attorneys.

B. Prior Art Rejections

1. The Invention

Applicants have invented an improvement to wireless technology which allows multiple accounts to be internally stored and managed within the wireless device. In some preferred embodiments, these multiple accounts include prepaid accounts and credit limit accounts. In other preferred embodiments, the internally stored accounts correspond to a first and second line. The first line might be used, for example, for business calls while the second line is used for personal calls.

2. The Cited Art Distinguished

Applicants' claims 1-3, 5-7, 9, 11, 25-26, 29 and 33 have been rejected as being "anticipated" under 35 U.S.C. § 102(e) by Carlsson's U.S. Patent No. 6,026,291 ("Carlsson patent"). The Carlsson patent discloses a cellular system in which multiple accounts for each cellular telephone can be maintained at the Home Location Register ("HLR") in the wireless provider's offices. In operation, the user can select an appropriate account which is then communicated to a computer at the wireless provider's offices. The wireless provider then calculates the appropriate call charges at their offices and applies those charges to the appropriate account maintained at their offices.

Applicants' invention is fundamentally different from Carlsson's network centric system. In Applicants' invention, the accounts are stored and maintained on the wireless device itself, rather than at a distant network computer. While the usage calculations in Applicants' invention can be made either on the wireless device or at the network, the calculated charges are applied to an appropriate account which is stored within the wireless device. If the appropriate internally stored account is a prepaid account or credit limit account, calls can be immediately restricted or cutoff when prepaid funds are exhausted or the credit limit is reached. Applicants submit that an advantage of maintaining the accounts within the wireless device, rather than on a

distant network computer as in the Carlsson patent, is that the user can readily see their account balance and usage limits can be more easily enforced in real time. Regardless of which system is superior, though, Applicants' pending claims are plainly not anticipated by the network centric Carlsson patent.

Applicants' claims 4, 10, 15-18, 20-22, 27, 30, 31 and 35-45 have been rejected as being "obvious" under 35 U.S.C. § 103(a) over the Carlsson patent in view of McGregor's U.S. Patent No. 5,577,100 ("McGregor patent"). Applicants are well aware of the McGregor patent since the McGregor patent is commonly owned with the present application and was discussed on the first page of Applicants' specification. While Applicants acknowledge that the McGregor patent discloses a pioneering wireless system where an account can be maintained on the wireless device, Applicants nonetheless submit that this pioneering McGregor disclosure does not render the present improvement inventions invalid for being "obvious."

On the issue of "obviousness," the Patent Office bears the burden of establishing a case of *prima facie* obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed.Cir. 1988). To determine whether or not the claimed subject matter can properly be viewed as being "obvious" under 35 U.S.C. § 103, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved... Such secondary considerations as commercial success, long felt but unsolved need, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966).

In order to properly combine references for an obviousness determination, there must be a suggestion or motivation in the references to make such a combination. *In re Gordon*, 733 F.2d 900, 902 (Fed.Cir. 1984)(*"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification"*). Moreover, a "useful general rule" is that references which "teach away cannot serve to create a *prima facie* case of obviousness." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed.Cir. 2001)(citations omitted). "Proceeding contrary to the accepted wisdom... is 'strong evidence of unobviousness.'" *Ruiz v. Foundation Anchoring Systems, Inc.*, 234 F.3d

654, 667 (Fed.Cir. 2000) (citations omitted). With these legal principles in mind, the merits of the obviousness rejections will now be addressed.

Turning first to the McGregor patent, while the McGregor patent discloses a wireless system where account information can be stored on the wireless device, it contains no disclosure or suggestion of the present invention of using *multiple* accounts stored on the wireless device. While, the Carlsson patent, on the other hand, has some teaching of multiple accounts, it affirmatively teaches away from the present invention by disclosing that such accounts need to be maintained at the network so that account information can be readily transferred between the home switch's HLR and a Visitor Location Register ("VLR") at a different switch when the cellular phone is "roaming" (see, Carlsson Fig. 2 and col. 5, lns. 22-34). Since there is no "suggestion" to combine the McGregor and Carlsson patents in the manner suggested by the Examiner and there is, in fact, an affirmative "teaching away", the McGregor and Carlsson patents cannot be combined to render any of Applicants' pending claims invalid as being "obvious."

Applicants' claims 8, 19 and 28 have been rejected as being "obvious" under 35 U.S.C. § 103(a) over the Carlsson patent in view of Julin's U.S. Patent No. 6,212,372 ("Julin patent"), either alone or in combination with the McGregor patent. Like the Carlsson patent, the Julin patent discloses a network centric system in which call charges can be made to either of two accounts. In Julin's preferred embodiments, the identities of the two accounts are stored at opposite ends of a subscriber identity module ("SIM"). By choosing which end of the SIM to insert into the mobile telephone, the user can select which account to use. When the user plugs a chosen end of the SIM into the mobile telephone, the selected account information is communicated to the HLR at the wireless provider's network computer (see, Julin patent, col. 4, lns. 43-49). The wireless provider's network computer then calculates call charges in the standard way and applies those call charges to the chosen account stored at the network computer. Since both the Carlsson and Julin patents disclose network centric systems and Applicants have invented a system where account information is stored and maintained on the wireless device, neither the Carlsson nor the Julin patents, alone or in any combination, would render any of Applicants' claims invalid as being "obvious."

Finally, Applicants' claims 12, 13-14, 23-24, 32 and 34 have been rejected as being "obvious" under 35 U.S.C. § 103(a) over the Carlsson patent in view of Vazban's PCT application number WO 97/45814 ("Vazban PCT Application") or "well known prior art." The Vazban PCT Application discloses a wireless terminal which can be used to make purchases or transfer electronic cash. In the preferred embodiment, Vazban's wireless terminal electronically collects purchasing information from an electronic vending device and sends that purchasing information back to a network computer to help consummate a purchase. The "well known prior art" purportedly discloses a prepaid account. Again, like the Carlsson and Julin patents, neither the Vazban PCT Application nor the "well known prior art" discloses Applicant's invention of a wireless device which allows the user to select an internally stored account from a plurality of internally stored accounts and then adjusts the selected internally stored account with the calculated usage charges. For these reasons, neither the Carlsson patent, the Vazban PCT Application nor the "well known prior art", either alone or in combination, would render any of Applicants' pending claims invalid as being "obvious."

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 576-0200.

Respectfully submitted,



Guy W. Chambers
Reg. No. 30,617

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
60361104 v1

Appl. No. 09/915,203
Amdt. dated December 23, 2004
Reply to Office Action of June 25, 2004

PATENT

Amendments to the Drawings:

The accompanying three sheets of formal drawings includes changes to Figs. 1-4. These three sheets of formal drawings replace the informal drawings which were submitted with the present application when filed.

Attachments: Three Replacement Sheets Of Formal Drawings